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EXAMINER

BATTULA, PRADEEP CHOUDARY

ART UNIT

PAPER NUMBER

3725

MAIL DATE

DELIVERY MODE

09/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 – 18, drawn to a security article having a multi colored image.

Group II, claim(s) 19 - 30, drawn to a method of manufacturing a security article.

Group III, claim(s) 31 - 45, drawn to a tamper evident security article having a multi colored image.

Group IV, claim(s) 46 - 57, drawn to a method of manufacturing a tamper evident security article having a multi colored image.

The inventions listed as Groups 1 – 3 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: In accordance with the guidance set forth in MPEP section 1850, it has been determined after taking the prior art into consideration, that the features common to all the claims, i.e the laminate layers each having an image of a different color and then when laminated together form an image, do not constitute "special technical features" since they do not make a "contribution" over the prior art in light of Jacobsen et al. (Jacobsen; U.S. 5,181,745). Jacobsen discloses an image in a first color on a first polymeric layer and then a second image of a second color on a polymeric layer wherein together they form an image and

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due to the polymeric composition of the layers the image can be viewed from either side of the laminate (Column 4, Lines 15 – 55; Figure 1).

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species 1 with Figures 1 – 3 including the laminate structure forming the multicolored system; Species 2 with Figure 4 having a fourth polymeric layer having the dark color black; Species 3 with Figure 5 which has OVI images above one of the laminating layers; Species 4 with Figure 6 has a transparent coating on the top and further has images in the OVI; Species 5 with Figure 7 has a polymeric coating on the second layer with the image embedded in that and not the layer itself; Species 6 with Figure 8 has a fourth layer of polymeric material with images of varying opacity; Species 7 with Figure 9, has two partial image portions forming an additional image where the partials form a front and back image; Species 8 with Figure 10 has two layers and a method of making with a deflector unit and laser source where the writing the first image is performed on one side then flipping and writing the second image; Species 9 with Figures 11 and 12 has multiple images and multiple layers where each layer is turned one by one so each can be written on; Species 10 with Figure 13 shows that a reflector of the laser is used.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply

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must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a). However, there currently is no generic Claim. The following claim(s) are generic: None.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: In accordance with the guidance set forth in MPEP section 1850, it has been determined after taking the prior art into consideration, that the features common to all the claims, i.e the laminate layers each having an image of a different color and then when laminated together form an image, do not constitute "special technical features" since they do not make a "contribution" over the prior art in light of Jacobsen et al. (Jacobsen; U.S. 5,181,745). Jacobsen discloses an image in a first color on a first polymeric layer and then a second image of a second color on a polymeric layer wherein together they form an image and due to the polymeric composition of the layers the image can be viewed from either side of the laminate (Column 4, Lines 15 – 55; Figure 1).

With respect to the Species Requirement, it is forthcoming. If Groups I or III are elected the Applicant is encouraged to call the Examiner in order to determine the which species and claims to be examined (unless Applicant would like to do this in writing as well in response to this correspondence) as currently the Groups and Species make it difficult to distribute all 57 claims into the appropriate species.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to

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be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./
Examiner, Art Unit 3725
September 25, 2009

/Dana Ross/
Supervisory Patent Examiner, Art Unit 3725